

**Amendment and Response**

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Confirmation No.: 2056

Filed: 31 July 2003

For: TEARABLE ELASTIC COMPOSITE ARTICLE AND METHOD OF MANUFACTURE

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**Remarks**

The Notice of Appeal filed in connection with this application is withdrawn in view of the Request for Continued Examination filed with this amendment. In this response, claims 1 and 14-18 are amended, claims 19-43 canceled, and new claims 44-60 are presented, leaving claims 1-18 and 44-60 pending. Reconsideration and withdrawal of the rejections set forth in the Final Office Action issued on June 8, 2005 are respectfully requested.

**Allowable Claims**

Applicants note that claim 13 was indicated as allowable in the Final Office Action issued on June 8, 2005.

Applicants have amended claims 14-17 to depend from claim 13 (thus correcting a typographical error in each of those claims such that they now properly depend from claim 13).

Applicants have also presented new claims 44-50 which also depend from claim 13. New claims 44-46 recite limitations presented in original claims 2-4 and new claims 47-50 recite limitations presented in original claims 8-11. As a result, Applicants respectfully submit that new claims 44-50 are supported by the application as filed.

In view of the allowability of independent claim 13 (as well as other reasons), Applicants respectfully submit that claims 13-17 and 44-50 are allowable as presented in this response. Notice to that effect is respectfully requested.

**Obviousness-Type Double Patenting Rejection**

Claims 1-12, 14-18, 42, and 43 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of copending Application No. 10/962,798 in view of Swanson et al. (U.S. Patent No. 6,383,958 B1) and WO 95/06449. Upon an indication of otherwise allowable subject matter and in the event this rejection is maintained, Applicants will provide an appropriate response.

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**The 35 U.S.C. §102 Rejection**

Claims 1-4, 7-12, and 15-18 were rejected under 35 U.S.C. §102(b) as being anticipated by Augst et al. (International Publication WO 95/06449). Appellants respectfully disagree.

With respect to claims 15-17, Applicants note that, as amended, these claims now depend from independent claim 13 which is not subject to this rejection. As a result, this rejection is moot with respect to claims 15-17.

Independent claims 1 and 18 of the present application each recite an elastic composite article including, *inter alia*, a plurality of elastic filaments located between the first coverweb and the second coverweb along the length of the article "wherein all of the elastic filaments located between the first coverweb and the second coverweb extend continuously over the entire length of the article."

In contrast, Augst et al. teaches elastic wraps wherein perforations are made in the elastic wrap, e.g., by a rotary die having a serrated perforator blade or by laser perforation (specification, page 17, lines 1-7). That is, the laminated composites of Augst et al. that include elastic filaments are perforated after the composites are laminated (e.g., after elastic filaments are bound to the nonwoven web (Augst et al., page 10, lines 12-13)).

Because the laminated composites of Augst et al. are perforated after the composites are laminated, and because the ratio of laterally extending perforation length to connecting segment length (e.g., the length of the composite between each perforation) is about 1:1 to 10:1 (Augst et al., page 3, lines 27-34), elastic filaments in the Augst et al. composites are severed as a result of the perforation process. This is demonstrated by, e.g., the reductions in tensile strength and percent elongation of the perforated samples as compared to the unperforated controls of the examples discussed in Augst et al. (*see, e.g.*, Tables 2-6, pp. 23-27 of Augst et al.).

For at least these reasons, Applicants respectfully submit that claims 1-4, 7-12, and 15-18 are patentable over Augst et al. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

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**The 35 U.S.C. §103 Rejections**

Claims 6 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over WO 95/06449. Applicants respectfully submit that this rejection is moot in view of the amendments to independent claim 1 and dependent claim 14. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

Claims 1-6, 8-12, 14, 16-18, 42, and 43 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hansen et al. (U.S. Patent No. 4,984,584) in view of Swanson et al. (U.S. Patent No. 6,383,958 B1). Applicants disagree and submit that this rejection fails to provide one or more of the essential elements needed for a *prima facie* obviousness rejection.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves, the knowledge generally available to one of ordinary skill in the art, or the nature of the problem involved, to modify a reference or combine reference teachings. Second, there must be a reasonable expectation of success, i.e., a reasonable expectation that the benefit result will be achieved. And third, the prior art reference(s) must teach or suggest all the elements and limitations of the claims. Applicants respectfully assert that the Office Action does not meet all of these criteria, and therefore fails to set forth a *prima facie* case of obviousness.

As amended, independent claims 1 and 18 of the present application each recite an elastic composite article including, *inter alia*, a plurality of elastic filaments located between the first coverweb and the second coverweb along the length of the article "wherein all of the elastic filaments located between the first coverweb and the second coverweb extend continuously over the entire length of the article."

Hansen et al. teach a high elastic modulus, cohesive compression bandage that provides joint support (Hansen et al., abstract). As admitted in the non-final Office Action mailed 25 February 2005 (page 4, paragraph 10), the bandages of Hansen et al. do not include tear lines.

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Appellants further assert that there is no discussion in Hansen et al. regarding tearability of the bandages.

Swanson et al. provide nonwoven sheets that may include embossed patterns to enhance tearing properties of the article (Swanson et al., abstract).

In support of the above rejection, it has been asserted that modifying the laminated elastic composites of Hansen et al. to include the embossed sheets of Swanson et al. will result in a tearable elastic composite structure. No evidence or reasoning has, however, been provided as to why or how a person of ordinary skill would reasonably expect or know that the combination would work, i.e., that the result would be a tearable elastic composite article.

Swanson et al. itself does not teach or suggest that the tearability of its embossed nonwoven sheets would survive lamination in composite that includes elastic filaments as disclosed in Hansen et al. Nor does the Office Action contain any reasoning as to why the elastic filaments would not destroy the tearability provided by the embossed patterns of Swanson et al.

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *MPEP* § 2143.01(III), p. 2100-137 (8<sup>th</sup> Ed., Rev. 3, August 2005) (emphasis in original) (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). In the present rejection, although individual elements of the claims may be found in the cited references, no showing has been made that the prior art "suggests the desirability of the combination." Rather, the rejection is based on desirability of the tear pattern in Swanson as applied to nonwoven sheets – not-composite articles including elastic filaments such as those recited in independent claims 1 and 18. For at least that reason, Applicants respectfully submit that a *prima facie* case of obviousness has not been established.

In essence, this rejection is the result of impermissible hindsight reconstruction. In setting forth an obviousness rejection, one cannot "simply engage in a hindsight reconstruction of the claimed invention, using the Appellant's structure as a template and selecting elements from

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references to fill the gaps.” *In re Gorman*, 933 F.2d 982, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991).

In addition, it was asserted in the Final Office Action issued 8 June 2005, that Swanson et al. disclose that a strong product with “acceptable” tensile strength that may be used throughout the health care and athletics fields (Swanson et al., abstract and col. 16, lines 36-56), and that providing the primary reference’s product (Hansen et al.) with the tear line structure of the secondary reference (Swanson et al.) would not result in a product unsuitable for its intended use. Applicants respectfully disagree.

Applicants have noted before that the support bandages of Hansen et al. are directed to providing joint support without undue constriction, and providing compressive force to support ligaments and flexor tendons, e.g., in the leg of a horse (Hansen et al., abstract). The tear lines of Swanson et al. may provide “acceptable” tensile strength for, e.g., tapes commonly used in the health-care industry (for affixation of a variety of articles such as dressings and tubings, and as affixation materials for products such as diagnostic electrodes, surgical grounding plates, and monitoring electrodes (Swanson et al., col. 1, lines 13-20)). There is no support, however, for an assertion that tear lines, such as provided by embossed patterns in the articles of Swanson et al., would not weaken the bandage to the point that it would not supply adequate support to the joint, and may even separate under the stress of use.

Because the asserted combination/motivation of introducing tear lines into the support bandages of Hansen et al. could be expected to render the bandages unsuitable for their intended purpose, Applicants respectfully assert that the art does not suggest the desirability to combine the references.

For at least the above reasons, Applicants submit that a *prima facie* case of obviousness has not been established for the rejection of claims 1-6, 8-12, 14, and 16-18 under 35 U.S.C. §103(a) as being unpatentable over Hansen et al. in view of Swanson et al. Reconsideration and withdrawal of the rejection are, therefore, respectfully requested.

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Summary

It is respectfully submitted that pending claims 1-18 and 44-60 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted by

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 22<sup>nd</sup> day of February, 2006, at 9:20 a.m. (Central Time).

By: Rachel Castaldi-GrahamName: Rachel Castaldi-Graham